

REMARKS

The rejection of claims 1-14 as being unpatentable over Morrison et al. under 35 U.S.C. § 103(a) is traversed, and reconsideration thereof is respectfully requested.

To make a *prima facie* case of obviousness, the Patent and Trademark Office is required to show that an objective teaching on the prior art to modify a reference comes explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art or, in some cases, the nature of the problem to be solved. *In re Katzab*, 217 F. 3d 1365, 1370 (Fed. Cir. 2000). Conclusory statements do not adequately address the issue of motivation to modify or combine prior art. *In re Lee*, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002). Obviousness cannot be predicted on “subjective belief and unknown authority.” *Id.* Subjective belief and unknown authority are the primary basis for the rejection of claims 1-14.

Subjective belief underlies the inference drawn in the Office Action that a v-shaped grove is suggested as being within ordinary skill by the general description at column 3, lines 33-46 of the Morrison et al. patent. That general statement provides no such specific teaching, as Section 103(a) requires, but the relevance of the conclusion is questioned in light of the actual claim language.

Unknown authority is likewise utilized in the Office Action by reliance upon the taking of Judicial [sic, Official] Notice “that marking one type of ophthalmic lens (a contact lens) lends itself to marking other types of ophthalmic lenses (10Ls and spectacle lenses).” As MPEP § 2144.03 makes clear, however,

Official Notice is not to be taken unless the Examiner is capable of identifying facts that could be instantly and unquestionably demonstrated as to defy dispute. The groundwork for Official Notice has not been properly laid in this case. Therefore, the Examiner is not in the position to draw the legal conclusion of obviousness as expressed at page 3 of the Office Action.

In fact, Applicant notes that methods of marking contact lenses are not automatically transferable to the marking of spectacle lenses. One reason is the difference in materials would make a method usable for marking contact lenses unusable for marking spectacle lenses. The unbridgeable difference between the Morrison et al. markings and that of the present invention further resides in the fact that Morrison et al. use depressions in the surface produced by etching whereas the present invention used protrusions from the front and/or rear surfaces of the lens produced by casting. The teachings of Morrison et al. vis-à-vis that of the present invention is a classic case of "apples and oranges."

Accordingly, early and favorable action is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 100341.53240US).

Respectfully submitted,

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